

REMARKS

The following amendments and remarks are responsive to the USPTO communication in the above-identified application, mailed on November 22, 2005.

Claims 1-7 were pending in this application. Claims 1-7 remain in this application.

Claims 1-7 stand as finally rejected for the reasons stated in the Detailed Action attached to the Office Action Summary (PTOL-326) mailed with the USPTO communication.

First, the Examiner rejected claims 1-7 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement thereof. In the applicants' response to the previous Official Action, claim 1 was amended to add the descriptive term "resin saturable" paper, which term lacks support in the original disclosure. Therefore, following the Examiner's suggestion for correction, the term "resin saturable" is deleted from the claim and the term "saturating kraft," which is supported in the original disclosure, is substituted therefor. Inasmuch as the remaining rejected claims, 2-7, ultimately depend from amended claim 1, it is respectfully submitted, therefore, that the rejection of claims 1-7 under 35 U.S.C. § 112, first paragraph, has been overcome.

Secondly, the Examiner rejected claims 1-5 and 7, under 35 U.S.C. § 103(a), as obvious over the teaching of US Patent No. 3,215,579 to Hagen, in view of US Patent No. 2,229,621 to Bradner. In addressing the application claims under 35 U.S.C. § 103(a), the Examiner is assured that her assumption that the subject matter of the various claims were commonly owned at the time any inventions covered therein were made. (This fact was noted earlier in the response filed on September 1, 2005.)

The teaching of Hagen is relied on for suggesting the elements of claims 1, 3-5, and 7. The teaching of Bradner is relied on for suggesting the element in claim 2 of "on machine" application of the salt treatment step. In particular, the Examiner addresses the limitation as to a "resin saturable paper not treated for sizing" (now, a "saturating kraft paper not treated for sizing," as amended herein). Then the Examiner follows by noting that "[T]he paper in Hagen is a standard saturating type kraft paper (col. 4, lines 70-71). The Examiner does not address, however, that Hagen also teaches (at col. 4, lines 29-39), "...a sequence of steps wherein the paper web is first sized with the alkaline earth metal or earth metal salt, *then is impregnated*

throughout with a thermosetting synthetic resin...” Moreover, it was related to the Examiner in the interview held on August 29, 2005, that every single one of Hagen’s examples employed this critical step. The step is critical because the sizing sheet prepared in its absence does not function. Yet, the Examiner in the prosecution of Hagen allowed claims not requiring that which Hagen taught in his examples was a necessary step.

In the Examiner interview, noted above, the relevance of the Jaisle et al. patents (I—US 4,243,461 and II—US 4,263,073) was discussed. Jaisle I teaches, at col. 2, lines 52-54, and Jaisle II teaches, at col. 2, lines 54-56, that “Only by incorporating a phenolic resin was Hagen able to produce a satisfactory release sheet.” Both Jaisle I and II teach avoiding use of the saturable paper (or saturating kraft), which is sized throughout during the process of converting it into a release sheet, by substituting a paper web having a water absorption of at least 200 seconds, which is coated with an aqueous solution of a water-soluble alkaline earth material or earth metal salt, then coating the same surface with a film of a salt of alginic acid. See the “Summary of Invention” language in both Jaisle I and II.

The applicants also have amended claim 1 hereby to recite “consists essentially of” in place of “comprises.” Therefore, the Examiner does not have the benefit (in making the rejection of obviousness) of ignoring Hagen’s teaching at col 4, lines 29-39, and the teaching of Hagen’s every example. Also, though the Examiner has dismissed out of hand the applicants’ previous arguments regarding what are the implications of the teaching of Jaisle I and II regarding the teaching of Hagen, one skilled in the art cannot be presumed not to be aware of art the Examiner may wish to ignore (or at least, to not consider). It is respectfully submitted that the more limited scope of claim protection, as amended, would not include either the process described or suggested by Hagan, Jaisle I, or Jaisle II. Therefore, rejected claims 1, 3-5, and 7, as amended, are patentable under 35 U.S.C. § 103(a) over the known prior art.

Moreover, as the secondary reference of Bradner is relied on merely as a prior art suggestion for the claim limitations in dependent claims 2 (“on-machine” application of the water-soluble multivalent salt solution to the paper web) and 6 (where the water-soluble salt is calcium propionate), said claims are patentable for their dependency upon a patentable

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independent claim 1. Therefore, it is respectfully submitted that rejected claims 1-5, and 7, as amended, are patentable under 35 U.S.C. § 103(a) over the known prior art.

Also, pending claim 6 stands rejected under 35 U.S.C. § 103(a) as obvious over the teaching of Hagen and Bradner, as applied above, and further in view of US Patent No. 6,17,702 to Malhotra et al. or in view of the Bauer article, "Corrosivity of Calcium Salt Solutions," cited in the IDS filed December 6, 2004. It is deemed, however, unnecessary to refute or discuss the rejection in reliance on the dependency of claim 6 on one or more patentable claims for its patentability. Therefore, it is respectfully submitted that rejected claims 1-7, as amended, are patentable under 35 U.S.C. § 103(a) over the known prior art.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. In the event that the Examiner deems the amendments and arguments fall short of rendering the claims, as amended, patentable over the cited (and uncited, re Jaisle I and II) art, it is further respectfully requested that the amendments be considered acceptable and applied for the purposes of appeal.


If the Examiner believes, for any reason, that personal communication will expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

No additional fees are believed to be due in connection with the filing of this amendment and response. Should it be determined that additional fees are due and payable, the Commissioner is authorized to charge any required fees or credit any overpayment to the assignee's Deposit Account No. 23-1160.

Respectfully submitted,

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